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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,844	04/05/2000	Toshitsugo Ono	P00,0251	6442

7590

11/30/2001

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 11/30/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/543,844

Applicant(s)

ONO ET AL.

Examiner

Lawrence D Ferguson

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1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections – 35 USC 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 1, “major surfaces” is indefinite. It is not clear what part of the support is the major surface.

- b. In claim 5, the term, H is indefinite because it is not defined.

- c. In claim 8, the phrase “on light transmitting layer” is indefinite. Examiner suggests the claim language be changed to “on *said* light transmitting layer”.

- d. In claim 17, the phrase, In, Sn and Sn is indefinite. Applicant claims the same metal element twice.

***Claim Rejections – 35 USC § 103(a)***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11, 14-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being obvious over Kondo et al. (U.S. 5,536,425).

5. Konda teaches recording mediums which comprise non-magnetic support and a layer formed on the support on the surface having a coefficient of friction (column 1, lines 16-22), Konda discloses perfluoropolyether derivatives for recording mediums (column 1, lines 62-64). Konda discloses the formula  $R-COO-R1-N+R2R3R4$  where R, R2, R3 and R4 represents H or a hydrocarbon group having from 6 to 22 carbon atoms (column 2, lines 8-17) as a derivative used in recording mediums. Konda discloses a top coat layer (column 2, line 58) and non-magnetic supports including ceramic and glass substrates (column 8, lines 35-41) which constitutes a light transmitting layer that can be illuminated by light along with resin binders (column 8, lines 51-59) including organic materials. Konda discloses a non-magnetic support made by sputtering (column 9, lines 9-10) with a coat layer formed on the support (column 9, lines 14-15). Konda discloses a coefficient of friction measurement (column 11, lines 55-56). Although Konda does not disclose the precise thicknesses, thickness variation, hardness, surface resistance, dynamic frictional coefficient, surface tension or moisture absorption, it would have been obvious to one

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of ordinary skill in the art to optimize the components since discovering the optimum or workable ranges involves only routine skill in the art.

***Claim Rejections – 35 USC § 103(a)***

6. Claims 10, 12-13, 17 and 20 are rejected under 35 U.S.C. 103(a) as being obvious over Kondo et al. (U.S. 5,536,425) in view of Akutsu (U.S. 5,864,357).

7. Konda is relied upon for claims 1-9, 11, 14-16 and 18-19. Konda does not disclose inorganic material made of  $\text{SiO}_x$ , said surface layer formed of an electrically conductive material consisting of indium oxide or tin oxide or In or Sn.

Akutsu teaches a light transmitting electrically conductive layer (column 2, lines 49-50) consisting of  $\text{SnO}_2$ ,  $\text{In}_2\text{O}_3$  (column 4, lines 47-49) and silicon nitride and silicon carbide (column 5, lines 59-60) used in a recording material (column 7, line 21). Akutsu teaches using a spray coating method (column 4, line 52).

Konda and Akutsu are analogous art because they are from the same field of recording media. It would have been obvious to one of ordinary skill in the art to include the light transmitting electrically conductive layer consisting of  $\text{SnO}_2$ ,  $\text{In}_2\text{O}_3$ , silicon nitride and silicon carbide in the recording medium of Konda because Akutsu teaches that these components are used to increase the resistivity and hardness of the recording medium.

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**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
November 14, 2001

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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